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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/534,689	03/24/2000	Shigeo Suzuki	1232-4396US1	1838
27123	7590	09/15/2005	EXAMINER	
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			BAYAT, BRADLEY B	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 09/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/534,689	<b>Applicant(s)</b> SUZUKI, SHIGEO	
	<b>Examiner</b> Bradley B. Bayat	<b>Art Unit</b> 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2005.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 43-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 43-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 24, 2005 has been entered.

### ***Status of Claims***

This communication is in response to amendment filed on June 24, 2005.

- New claims 47-49 have been added.
- Claims 43-49 remain pending and presented for examination on the merits.

### ***Response to Arguments***

Applicant's arguments with respect to claim 43-46 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112, 1<sup>st</sup> paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

New claims 47-49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed

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invention. The claims describe a “detector” mechanism that was not described in the disclosure as originally filed.

***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 43-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claims 43-46, applicant recites “information indicating a watching and listening unit time...” The specification discloses that the “watching and listening” refers to an audience members’ “actual” viewing (specification p. 4). It is unclear and indefinite as recited by the claims, how the “actual” watching and listening unit is determined as per the language of the claims. For instance, applicant must particularly point out and distinctly claim how such “actual” watching and listening unit is performed, as disclosed in the specification.

As per claims 47-49, applicant claims a receiving apparatus, however, the functional language fails to set definite boundaries as to the claimed subject matter. See *In re Barr*, 170 USPQ 33 (CCPA 1971). Applicant utilizes functional limitations followed by “adapted to...” language to describe the apparatus as claimed. A software module can perform for instance, “a requester adapted to issue a request of a decoding key...” Therefore, the claims as recited fail to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 43-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blatter et al. (5,933,500) in view of Weiss (4,856,062).**

Claims 43 and 46: Blatter discloses an encrypted data transmitting method/computer readable medium comprising the steps of: encrypting data by using a key; transmitting the key and information indicating a time until changing to a next key to a receiving side; transmitting information for decoding the encrypted data to the receiving side, in accordance with a request from the receiving side; executing transmitting of said information for decoding the encrypted data and recording a watching and listening time obtained by integrating the time until changing the key; changing the key for every time until changing the key (column 6, line 5-column 8, line 7; figures 1-4 and associated text).

Although Blatter describes encryption keys used to decrypt program content packets or units in a data stream (columns 13-14), it does not explicitly disclose charging based on a watching and listening unit time.

Weiss, however, teaches a system and method of dynamic time keeping means wherein automatic intervals of time are recorded based on intervals of time (column 3, lines 45-64). It would have been obvious for one of ordinary skill in the art at the time of the invention to incorporate a predetermined variable algorithm that constantly and dynamically tracked and

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charged based on actual usage of time in any predetermined increment desired and also provided a verification mechanism to prevent unauthorized access and usage, as per teachings of Weiss and Blatter.

Claim 44: A method according to claim 43, wherein the request from the receiving side is issued before the time until changing the key elapses (column 10, line 37-column 12, line 16).

Claim 45: A method according to claim 43, wherein the information for decoding the encrypted data is a key which data is encrypted (columns 13-14).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 47 (New): A receiving apparatus comprising: receiver adapted to receive encoded program data from a transmitting apparatus; requestor adapted to issue a request of a decoding key for the encoded program data, to the transmitting apparatus, wherein the issue is executed at predetermined intervals (column 4, lines 45-58); acquisition unit adapted to acquire the decoding key of the encoded program data, from the transmitting apparatus (fig 1, transport system); decoder adapted to decode the encoded program data by using the acquired decoding key (fig 1,

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decoder); reproducer adapted to reproduce a program which is decoded from the encoded program data by said decoder (column 13); detector adapted to detect whether instruction of a stop of program reproduction is inputted or not (column 5, lines 59-61); and controller adapted to control said requestor to stop issue of the request in accordance with the detection by said detector (column 5, lines 7-15; see figure 1, video receiver system and associated text).

Claim 48: (New) An apparatus according to claim 47, wherein the decoding key is changed at predetermined intervals at the transmitting apparatus (column 7, lines 30-column 8, line 7).

Claim 49: (New) An apparatus according to claim 47, wherein said acquisition unit receives information indicating the predetermined intervals together (column 10, lines 1-65).

As per claims 47-49, the examiner notes that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone. See MPEP 2114. Since the examiner has reason to believe that a functional limitation can be performed by the prior art structure, the examiner has established a prima facie case, shifting the burden to the applicant to prove otherwise. See *In re Swinehart*, 169 USPQ 226 (CCPA 1971); *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997).

*Although the Examiner has pointed out particular references contained in the prior art(s) of record in the body of this action, the specified citations are merely representative of the teachings in the art as applied to the specific limitations within the individual claim. Since other passages and figures may apply to the claimed invention as well, it is respectfully requested that the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.*

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 43-46 are rejected under the judicially created doctrine of double patenting over claims 1-13 of U. S. Patent No. 6,061,452 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent. The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a transmitting method comprising steps of, transmitting encoded data which has been encoded, to a receiving side, changing the encoding in a predetermined unit, and performing recording according to requirement, from the



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receiving side of information concerning decoding of the encoded data, and a receiving method comprising steps of, receiving the encoded data which has been encoded, from a transmitting side, requiring the information concerning the decoding of the encoded data, to the transmitting side, and decoding the encoded data by using the obtained information concerning the decoding.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley B. Bayat whose telephone number is 571-272-6704. The examiner can normally be reached on Tuesday - Friday 8 a.m.-6:30 p.m. and by email: [bradley.bayat@uspto.gov](mailto:bradley.bayat@uspto.gov).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached regarding urgent matters at 571-272-6712.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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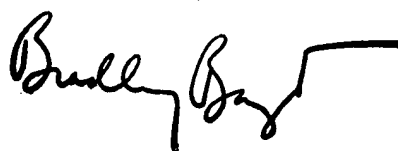
Any response to this action should be mailed to:

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Washington, D.C. 20231

Or faxed to:

**(571) 273-8300** - Official communications; including After Final responses.

**(571) 273-6704** - Informal/Draft communications to the examiner.

A handwritten signature in black ink, appearing to read "Bradley Bayat", with a stylized horizontal line extending from the end of the signature.

Bradley B. Bayat, Esq.  
Technology Center 3600, Art Unit 3621  
Patent Examiner  
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